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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,697	04/09/2004	Takuya Hayasaka	042326	8729

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EXAMINER

GRAY, LINDA LAMEY

ART UNIT PAPER NUMBER

1734

DATE MAILED: 08/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/820,697

Applicant(s)

HAYASAKA ET AL.

Examiner

Linda L. Gray

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 June 2006 and 26 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**Detailed Action**

**Request for Continued Examination**

**1.** A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on 6-26-06 has been entered.

**Claim Rejections - 35 USC 102**

**2.** The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**3. Claims 1-2 are rejected under 35 USC 102(b) as being anticipated by Funahashi (US 3,812,782).**

**Claim 1**, Funahashi teaches a sticking roller having shaft-shaped roller body 6 and elastic member 5 which is fitted on the outer circumference surface of body 6. Body 6 has a fitted part for fitting member 5 on the outer circumference surface, see Figures 7 and 10 demonstrating part 4"/7 and part 10/8/9/13/11. Member 5 is fitted in the fitting part wherein the top surface of member 5 is arranged above the outer circumference surface (c 3, L 25, to c 6, L 54; drawings).

The limitations of "for sticking a label to an adherend" and "and contacts with a non-adhesive face of said label" each refer to an intended use of the claimed product and do not provide a patentable distinction between the claimed product and that of Funahashi. The roller of Funahashi is capable of the intended use by placing a non-adhesive side of a label on the roller and applying the label to the adherend.

The limitation of "having a circumferential surface shape which is substantially identical to the shape of said label" refers toward a material operated upon (the label)

when using the claimed product in an intended use manner, and this limitation does not provide a patentable distinction between the claimed product and that of Funahashi. The roller of Funahashi is capable of operating on a label.

**Claim 2**, member 5 has a doughnut shape on the circumferential surface of the body in that member 5 is completely around the surface forming a hollow center for member 5 (which is filled with body 6) as shown in Figure 4 with the center forming the center of the doughnut shape. Note that the fitted part has stepped portions along the inner and outer edges of member 5 in Figures 7 and 10. The fitting part is considered capable of regulating a deformation or shift of member 5 on its surface direction during use since member 5 is elastic (deformable and shiftable) and the fitting part helps keep member 5 in place overall.

The limitations of "when a sticking force is applied to the label on the surface of said elastic member" refers to an intended use of the claimed product and do not provide a patentable distinction between the claimed product and that of Funahashi. The roller of Funahashi is capable of the intended use by placing a label on the surface of member 5 and applying a force thereto.

The limitations of "said adherent being an information recording board which has a nearly doughnut shape in a plan view" and "corresponding to the plan shape of said information recording board" each refer to a material operated upon (the adherend) when using the claimed product in an intended use manner, and these limitations do not provide a patentable distinction between the claimed product and that of Funahashi. The roller of Funahashi is capable of operating on such an adherend.

### **Response**

**4.** Applicant's comments filed 6-1-06 have been entered and considered.

With respect to claim 1 and "having a circumferential surface shape which is substantially identical to the shape of said label", this limitation refers toward a material operated upon (the label) when using the claimed product in an intended use manner, and this limitation does not provide a patentable distinction between the claimed product and that of Funahashi. The roller of Funahashi is capable of the intended use on such a label.

Applicants indicate that Funahashi does not teach that the elastic member is formed into a nearly doughnut shape on the surface of the roller body as in claim 2. In response, member 5 has a doughnut shape on the circumferential surface of the body in that member 5 is completely around the surface forming a hollow center for member

**Art Unit: 1734**

5 (which is filled with body 6) as shown in Figure 4 with the center forming the center of the doughnut shape.

The rejection of Weihrauch is withdrawn in that Weihrauch does not teach a fitting part for fitting member 12 on the surface of body 11 with member 12 being fitted in the fitting part. Specifically, the reference teaches member 12 placed on body 11 in the form of a known paint roll. Item 20 is a sleeve 21 having holes 22 where member 12 is fitted in holes 22. However, item 20 does not function to fit the member 12 on the outer surface of body 11 because item 20 is not required and member 12 functions on body 11 without item 20. Thus, member 12 is fitted to body 11 without item 20.

**Conclusion**

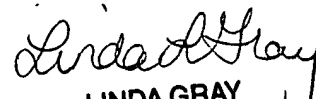
**5.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linda Gray whose telephone number is (571) 272-1228. The examiner can normally be reached Monday-Friday from 9:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla, can be reached at (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public Pair. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-1997 (toll-free).



llg  
August 21, 2006



LINDA GRAY  
PRIMARY EXAMINER